

As a preliminary matter, Applicant would like to thank Examiner Susan Coe for the courtesy extended during telephonic interview on 12 March 2002. During this phone call, the Examiner and the below signed attorney discussed amending the claims to recite "solid" and "pet food," as well as "a source of carbohydrates selected from sorghum, barley, and mixtures thereof." The Examiner agreed to consider these amendments and suggested that a Request for Continued Examination be filed.

The above account is believed to be a complete and accurate summary of the telephonic interview as required by 37 C.F.R. §1.133. If the Examiner believes that this summary is inaccurate or incomplete, Applicant respectfully requests that the Examiner point out any deficiencies in her next communication so that Applicant can amend or supplement the interview summary.

§102 Rejection of the Claims

Claims 1 and 8 were rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,104,677 (the '677 Patent). The '677 patent is directed to a liquid nutritional product that is suitable for tube feeding. See the title, the abstract, column 1, lines 1-10, and claims 1-22.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. In re Dillon, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the art. Scrapps Clinic & Res. Found. v. Genentech, Inc., 18 USPQ2d 101 (Fed. Cir. 1991).

The instant claims are directed to a composition which is a "solid." The '677 patent is directed to liquid compositions - suitable for enteral administration. Accordingly, it is respectfully submitted that the '677 patent does not anticipate the instant claims. Withdrawal of the rejection under 35 U.S.C. § 102 over the '677 patent is respectfully requested.

§103 Rejection of the Claims

Claims 1, 3-5, 8, 9 and 14 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 5,626,849 (the '849 patent), the Purina CNM Veterinary Product Guide

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(*Purina*), and U.S. Patent No. 5,240,962 (the '962 patent).

The Examiner stated that *Purina* teaches a food that comprises corn and Vitamin A, for lowering weight; that the '962 patent teaches that corn, sorghum, wheat, and barley are interchangeable as carbohydrate sources in weight loss compositions; and that the '849 patent teaches chromium and L-carnitine are useful in weight loss compositions.

The instant claims are directed to "a composition comprising an effective weight reducing amount of ..., and a source of carbohydrates selected from sorghum, barley, and mixtures thereof." As discussed in the instant specification at page 2, lines 16-20, and at page 3, lines 23-27, the claimed compositions comprise a low glycemic index grain selected from sorghum, barley, and mixtures thereof, which "improves glucose metabolism" and causes an individual to "feel satiated more often," consume less food, and lose weight. See page 3, lines 23-27.

The '962 patent reports certain specific phenols that are reported to be useful for treating obesity (see the abstract and column 2, lines 38-65). The '962 patent also reports that these active phenols can be administered by mixing the phenol into an animal's feed, for example "grains such as corn, sorghum, wheat, barley, oats, and the like...." See column 5, lines 19-40.

It is respectfully submitted that the '962 patent does not suggest that any of the grain sources discussed at column 5 would have any beneficial effect on weight reduction. They are simply reported to be "solid feeds" with which the active phenol compounds can be mixed. Additionally, the '962 patent suggest that all the listed grains are interchangeable as carriers for the active phenols. Finally, the grains listed in the '962 patent include wheat and oats, which are not low glycemic index grains.

The instant claims recite "a source of carbohydrates selected from sorghum, barley, and mixtures thereof." Applicant discovered that the recited low glycemic index grains have a beneficial weight reducing effect when the compositions of the invention are administered. The '962 patent would not have suggested the weight reducing advantage of the instantly claimed compositions. In fact, the '962 patent would have suggested that all the listed grains were interchangeable (including those that are not low glycemic index grains). Because the claimed compositions possess beneficial weight reducing properties, and because one skilled in the art could not have appreciated these beneficial properties from the information included in *Purina*,

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PRELIMINARY AMENDMENT
Serial Number: 09/639,522
Filing Date: July 5, 2000
Title: NUTRITIONAL COMPOSITION FOR WEIGHT MANAGEMENT

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the '962 patent, and the '849 patent, it is respectfully submitted that the claimed compositions are not obvious over the cited disclosures. Accordingly, withdrawal of the rejection under 35 U.S.C. §103 is requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612/359-3265) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

GREGORY D SUNVOLD ET AL.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Box RCE, Commissioner of Patents, Washington, D.C. 20231, on this 2nd day of May, 2002.

Robert J Harris [Signature]
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